

## **REMARKS**

### **I. Introduction**

Claims 1 and 3-6, 8-11 and 13-25 remain pending in the present application after cancellation of claims 7 and 12. Claims 3, 5, 7, 9, 10, 13-15, 17 and 19-22 have been withdrawn from further consideration by the Examiner; claims 1, 4, 6, 8, 11, 12, 18 and 23-25 have been rejected; and claim 16 has been objected to. In response, Applicant has amended claims 1, 6, 16, 23, 24 and 25. Entry of the amendments is requested since the amendments put the application in condition for allowance and do not raise any new issues. For at least the following reasons, Applicant submits that the present application is in condition for allowance.

### **II. Allowable Subject Matter**

In response to the Examiner's indication that claim 16 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, Applicant has rewritten claim 16 in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, claim 16 is now in allowable condition.

### **III. Objection to Specification**

In response to the Examiner's objection to the specification as containing informalities and failing to provide proper antecedent basis for the claimed subject matter, Applicant has corrected the specification as suggested by the Examiner. Claim 23 has been amended to recite "moving vehicle," which is fully supported by the specification, e.g., page 1. Accordingly, the objection to the specification should be withdrawn.

### **IV. Claim Objections**

In response to the Examiner's objection to claims 6 and 24-25, Applicant has amended claims 6 and 24-25 in accordance with the Examiner's suggestion. Therefore, the claim objection should be withdrawn.

**V. Rejection of Claims 1, 4, 6, 8, 11 and 12 under 35 U.S.C. § 102(e)**

Claims 1, 4, 6, 8, 11 and 12 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 4,801,958 ("Stoneham").<sup>1</sup> Claims 12 has been canceled, and its features have been incorporated into amended claim 1. Applicant respectfully submits that Stoneham fails to anticipate pending claims 1, 4, 6, 8 and 11, for the reasons explained below.

To anticipate a claim under 35 U.S.C. § 102(e), a single prior art reference must identically disclose each and every claim feature. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claim feature is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Furthermore, in order to rely on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). "Inherency, however, may not be established by probabilities or possibilities," i.e., "mere possibility that a certain thing may result from a give set of circumstance is not sufficient." In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

Claim 1 has been amended to incorporate the features of claim 12, i.e., amended claim 1 recites, in relevant parts, "an imaging element, plural optical systems having different focal lengths, a variable-transmittance element, and a reflective optical element consisting essentially of a reflective surface that is fixedly positioned, wherein a focal length of the imaging apparatus in its entirety is changed by controlling transmittance of the variable-transmittance element, and wherein the variable-transmittance element is free from any portion that is mechanically displaced in a photographing action." In support of the rejection of claim 1, the examiner contends that the "**combination of mirror 7' and aperture plane defining plate 17'**" of Stoneham is equivalent to the claimed variable-transmittance element, and that mirror 5' of Stoneham is equivalent to the claimed reflective optical element consisting essentially of a reflective surface that is fixedly positioned.

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<sup>1</sup> Although the Examiner states that the rejection is made under 102(e), Applicant believes the Examiner intended to cite 102(b) as the basis for the rejection.

However, the examiner subsequently contends in connection with the rejection of claim 12 that the aperture plate defining plate 17', by itself, is equivalent to the variable-transmittance element which is "free from any portion that is mechanically displaced in a photographing action," which interpretation is entirely inconsistent with the Examiner's interpretation made in connection with original claim 1. To the extent the Examiner initially interprets the combination of the mirror 7' and the aperture plane defining plate 17' as being equivalent to the claimed variable-transmittance element, this interpretation must be maintained consistently. In this regard, since the mirror 7' of Stoneham is moved in a photographing action, the combination of the mirror 7' and the aperture plane defining plate 17' of Stoneham allegedly reading on the claimed variable-transmittance element clearly does not satisfy the claimed limitation that variable-transmittance element is "free from any portion that is mechanically displaced in a photographing action."

For at least the foregoing reasons, amended claim 1 and its dependent claims 4, 6, 8 and 11 are not anticipated by Stoneham.

#### **VI. Rejection of Claim 18 under 35 U.S.C. § 103(a)**

Claim 18 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,801,958 ("Stoneham") in view of U.S. Patent No. 5,471,339 ("Ise") Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner

must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 18 depends on claim 1. As discussed above, Stoneham clearly fails to anticipate parent claim 1. In addition, Ise fails to remedy the deficiencies of Stoneham as applied against claim 1. Accordingly, the combination of Stoneham and Ise fails to render obvious claim 1 or its dependent claim 18.

**VII. Rejection of Claim 23 under 35 U.S.C. § 103(a)**

Claim 23 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,801,958 ("Stoneham") in view of U.S. Patent No. 5,155,683 ("Rahim") Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 23 depends on claim 1. As discussed above, Stoneham clearly fails to anticipate parent claim 1. In addition, Rahim fails to remedy the deficiencies of Stoneham as applied against claim 1. Accordingly, the combination of Stoneham and Rahim fails to render obvious claim 1 or its dependent claim 23.

#### **VIII. Rejection of Claims 24-25 under 35 U.S.C. § 103(a)**

Claims 24-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,801,958 ("Stoneham") in view of U.S. Publication 2001/0005232 ("Yoshioka"). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claims 24-25 depend on claim 1. As discussed above, Stoneham clearly fails to anticipate parent claim 1. In addition, Yoshioka fails to remedy the deficiencies of Stoneham as applied against claim 1. Accordingly, the combination of Stoneham and Yoshioka fails to render obvious claim 1 or its dependent claims 24-25.

**IX. Conclusion**

In view of the foregoing, it is submitted that all of the presently pending claims 1, 4, 6, 8, 11, 18 and 23-25 under consideration are in allowable condition.

Since the Examiner has previously indicated that claim 1 is a generic claim encompassing Species I – XI noted in the Restriction Requirement of 5/3/07, and since claim 1 now in allowable condition, Applicant requests rejoinder and consideration (pursuant to 37 CFR 1.141) of withdrawn claims 3, 5, 9, 10, 13-15, 17 and 19-22, all of which depend on allowable claim 1 (and are allowable by virtue of their dependence on allowable claim 1).

Respectfully submitted,

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